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10/754,391	01/09/2004	Daniel H. Schneider	043210-1550-00	7833

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EXAMINER

SKURDAL, COREY NELSON

ART UNIT	PAPER NUMBER
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3782

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/754,391

Applicant(s)

SCHNEIDER, DANIEL H.

Examiner

Corey N. Skurdal

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5, 7-11 and 13-30 is/are rejected.
7) ☒ Claim(s) 6 and 31 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 7, 8, and 26-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al. (US 5,271,540).

Regarding claims 1, 8, 26, 27 Katz discloses a saddlebag mounting system capable for use with a motorcycle having a fender support, the mounting system comprising: a saddlebag 27 having a lower end and upper end, the saddlebag defining a cavity that is accessible by movable cover at lead line 29 from the upper end of the saddlebag; and a saddlebag frame 33 fixedly attached to the saddlebag and including an integral hook member 77 configured to hang from a portion of a motorcycle to support the saddlebag; the saddlebag frame further includes first and second attachment members 69/73 spaced apart from each other and substantially inhibiting upward movement of the saddlebag; and wherein the hook member is shown above and between the first and second attachment members.

Regarding claims 7, 28, and 29, Katz discloses a yoke member 35 for partially supporting the saddlebag frame, in particular noting that no structure is recited as to what constitutes a yoke member.

Regarding claim 30, the attachment members 69/73 are considered pins in that a pin may be defined as a projecting peg, nail or stud.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. in view of Monson (US 2003/0122002) and Campbell (US 6,499,638).

Regarding claims 2 and 3, Katz discloses the invention substantially as claimed including a saddlebag mount at lead line 23, and a bar 41 with attachment members 49/51, but does not have the mount attached to the fender support on a motorcycle. However, Campbell teaches that it is well known to secure a saddlebag to a motorcycle through a saddlebag frame portion 3 and a saddlebag mount portion 2, wherein the saddlebag mount portion is provided with spaced apart mounting points 10. Furthermore, Monson teaches that it is well known to mount a saddlebag 10 to a fender strut 14 via attachment members 42, the fender strut 14 holding the fender 24 above the wheel and therefore being considered a fender support (see paragraph 44 of Monson). Therefore it would have been obvious to one skill in the art at the time of invention to attach the Katz et al. mounting system to a motorcycle fender support in order to provide a carrier on a motorcycle. In doing so, the interface/saddlebag mount 23 would be mounted to the fender support in the manner taught by Campbell, with spaced mounting holes 10.

Regarding claim 4 and 5, modified Katz discloses attachment members 49/51 that are considered pins in that a pin may be defined as a projecting peg, nail or stud.

5. Claims 9-11, 13, 14, 16-22, and 24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Monson (US 2003/0122002).

Regarding claims 9, 16, 18, and 24 Campbell discloses a saddlebag mounting system capable for use with a motorcycle having a fender support substantially as claimed, including: a saddlebag 1 having a saddlebag mount 2 wherein the saddlebag mount includes a first and second mounting axis disposed through the first and second mounting holes 10; a saddlebag frame 3 having an attachment axis disposed through the attachment points 6, whereby the mounting axes and attachment axis are not aligned. Furthermore, Campbell discloses the saddlebag mount including bar member 2 having a first side facing the saddlebag frame and a second side opposite the first side (see Examiners Figure 2) and having a cavity (shown in Examiners Figure 2 shaded in) formed within the lip 7, the cavity having an opening which can face in any number of directions, including away from the saddlebag and toward the fender support, and wherein first and second attachment members 8 of the bar are disposed within the bounds of cavity.

Campbell does not disclose that the mounting system is secured to the fender support of a motorcycle, or the use of a yoke member engageable with the motorcycle. However, Monson teaches the use of a saddlebag mounting system attached to a fender strut 14, the fender strut 14 holding the fender 24 above the wheel and therefore being considered a fender support (see paragraph 44 of Monson). Monson also teaches

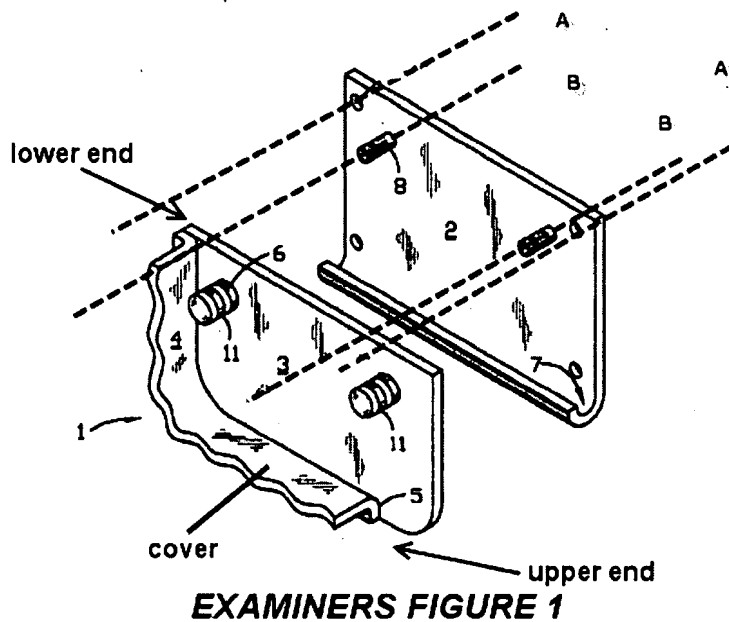
the use of a yoke member 94' (Fig. 3A) formed as part of the saddlebag frame 44'' for the purpose of supporting the saddlebag. Therefore it would have been obvious to one skill in the art at the time of invention to provide Campbell with attachment to the motorcycle fender support in order to increase the strength of the attachment point, and also to provide the saddlebag frame of Campbell with a yoke member extending from the motorcycle in order to provide additional support for the saddlebag.

Regarding claims 10, 11, 19, and 20, modified Campbell discloses hook member at lead line 5 integrally formed as part of the saddlebag, said hook adapted to couple a portion of the motorcycle and partially support the saddlebag.

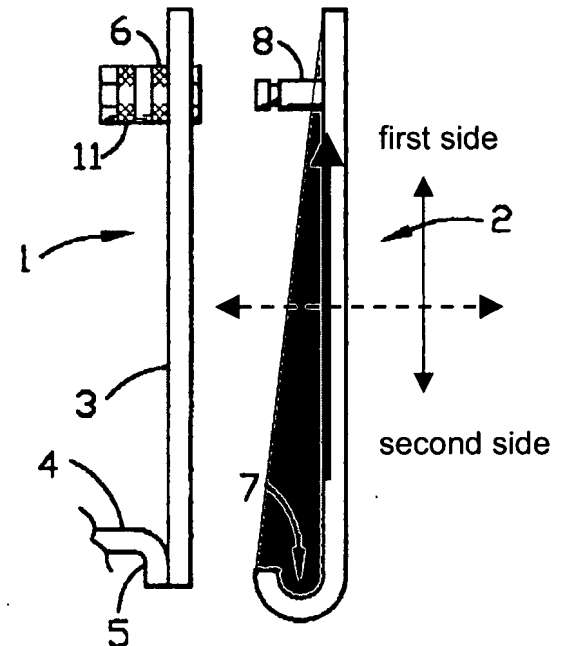
Regarding claims 13 and 21, the modified Campbell device discloses the claimed invention including: first and second attachment members 8 disposed between the first and second mounting axes, the attachment members adapted to couple the saddlebag.

Regarding claims 14 and 22, the modified Campbell device discloses first and second pins 6 engageable with attachment members 8 on the saddlebag mount.

Regarding claim 17, the modified Campbell device discloses mounting axes (A in Examiners Figure 1 shown below) and attachment axes (B in Examiners Figure 1 shown below) in the claimed configuration including mounting axes through parallel spaced holes 10, and attachment axes oriented parallel each other and between said mounting axes.



Examiners Figure 2



6. Claims 15, and 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Monson and in further view of Ralph et al (US 2,887,753). The modified Campbell device discloses the invention substantially as claimed as applied above, but the modified Campbell device does not disclose first and second pin members with a cam surface that engages the first and second attachment members. However, Ralph et al teaches the use of a fastening device with quick connect and disconnect ability with pin 12, cam surface 11, S-spring 10 wherein the cam surface engages the spring. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to exchange the quick disconnect pins and attachment

members of Campbell with the quick disconnect pin 12 and attachment member 10 of Ralph et al, in order to increase the strengthen of the attachment points.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell in view of Monson as applied to claim 18 above, and further in view of Seibel (US 6,347,804). The modified Campbell device discloses the invention substantially as claimed but does not have a pair of spacers for supporting an accessory. However, Seibel teaches the use of mounting member 24 with spacer's 36a for the purpose of supporting an accessory such as a backrest. Therefore it would have been obvious to one skill in the art at the time of invention to provide the mounting system of Campbell with spacers at behind mounting holes 10 in order to provide an additional mounting point for accessories.

Allowable Subject Matter

8. Claims 6 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to claims 1-8, and 26-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 9 and 18 have been fully considered but they are not persuasive. Applicant has argued that the combination of Campbell and Monson fails to disclose a bar having a first side facing the saddlebag frame, and a second opposite side facing away from the saddlebag frame and toward the fender

support. However, as noted in Examiners Figure 2, the bar 2 of Campbell can be defined having two opposite sides, wherein each side faces both toward and away from the saddlebag frame.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corey N. Skurdal whose telephone number is 571-272-9588. The examiner can normally be reached on M-Th 8am-4pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571-272-4544. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CNS
11/13/07


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER